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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,550	06/11/2001	Richard Bastiansen	BAST/001/US	2603
7590	03/21/2006		EXAMINER	
Brian M. Dingman, Esq. Mirick, O'Connell, DeMallie & Lougee, LLP 100 Front Street Worcester, MA 01608			MILEF, ELDA G	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,550	BASTIANSEN, RICHARD	
	Examiner	Art Unit	
	Elda Milef	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Refer to page 3 of the Declaration and alterations to the zip code.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the limitation "the filled-in amounts" (line 9), and "the correct funds transfer" (line 10). There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the funds transfer" (line 1). There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the new form" (line 1). There is insufficient antecedent basis for this limitation in the claim.

Claims 4,5 recite the limitation "the adding step" (line 1). There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recite the limitations "the adding step" in line 9, "the filled-in amounts" in line 12, "the correct funds transfer" in line 13, "the new form" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the adding step may be accomplished at least in part by the customer, and is accomplished at least in part by being printed on the form by the financial institution. It is unclear to the Examiner how the adding step is accomplished by being printed on the form.

Claims 6-10 are rejected because of their dependency to the rejected claims.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4,5,and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Perazza (US Patent No. 5,326,959).

Re claim 1:

The Examiner is interpreting "filled-in amounts" to mean the amounts to be paid to the appropriate payees. The Examiner is interpreting "the correct funds transfer" to mean the amount to be paid to the appropriate payees that is transferred by the bank.

Perazza discloses:

the customer determining payees to be included in the method ("Pre-Register means to provide a Payer's Bank with the following minimum information for a biller, as to a Bill Payer...")-see col. 2 lines 34-49, and col. 5 lines 56-63.

the financial institution providing to the customer a form with one listing per selected payee, including at least the

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payee name and a designated area to carry an amount to be paid to at least one such payee-("the bank produces a paper form, which is manually completed by the customer...The customer manually inserts the amount to be paid for each bill being processed by the system, opposite pre-printed indicia indicating the identity of the payee.")-see Abstract, and col. 6 lines 10-26;

adding into one or more of the areas the one or more amounts to be paid to the appropriate payees ("The CPI provides space for the Bill Payer to designate manually, in machine-readable form, two things, i.e., whether each listed Bill is to be paid on the Designated Date or immediately, and the amount of the Bill to be paid.")-see col. 5 lines 59-63;

and in response to the filled-in amounts, at the direction of the financial institution, accomplishing the correct funds transfer to the appropriate payees ("the Payer's Bank has all information which it needs to be able to transfer funds to and credit the Biller's account and to provide Remittance Instructions to the Biller's Application, while debiting the account of the Bill Payer accordingly.")-see col. 6 lines 53-59.

Re claim 2: The Examiner is interpreting "the funds transfer" to mean the transfer of the amounts to be paid to the biller.

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Perazza discloses:

after accomplishing the funds transfer, the financial institution providing another form, and indicating on such form the most recent amount paid to each listed payee. -see col. 15 line 63-col. 16 line 26.

Re claim 4: The Examiner is interpreting "the adding step" to mean designating the amount of the bill to be paid.

Perazza discloses:

wherein the adding step is accomplished at least in part by the customer. ("The CPI provides space for the Bill Payer to designate manually...the amount of the Bill to be paid.")-see col. 5, lines 59-63.

Re claim 5: The Examiner is interpreting "the adding step" to mean designating the amount of the bill to be paid.

Perazza discloses:

wherein the adding step is accomplished at least in part by the financial institution. ("Some Bills (mortgages, car loans, and the like) are fixed sums, payable each month, and each fixed amount can be Pre-Registered in the system of this invention, so that in these instances, at the option of the Payer's Bank, no information needs to be completed on the CPI, unless the Bill Payer wants to change the payment amount or the Designated Date.")-see col. 6 lines 21-27.

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Re claim 8: Perazza discloses:

financial institution creating and maintaining customer payee information comprising a unique identifier for each payee of a customer.-see col. 12 lines 1-5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3,6,7,9, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perazza in view of Simmons (US Patent No. 5,093,787).

Re claims 3 and 7: The Examiner is interpreting "the new form" to mean the statement provided to the customer by the financial institution which shows payments processed on behalf of the customer.

Although Perazza discloses a monthly account statement sent by the financial institution to the bill payer at the end of the

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month containing bill payment details -see cols. 15 and 16, Perazza does not specifically disclose wherein the new form also includes the amount paid of each listed payee year-to-date, and after the end of a calendar year, the financial institution preparing for the customer a summary of the amount paid by the customer to each payee.

Simmons however, teaches printing requested data for a payee and specified date ranges. -see Figs. 26 and 27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Perazza to include a financial institution providing a payment history to a customer for the desired date range, as was taught by Simmons in order to allow the customer to budget his/her finances.

Re claim 6: Perazza does not disclose:

Categorizing payees into budget categories, and indicating such on the form. Simmons, however teaches categorizing payees into tax categories such as Medical and Entertainment- see FIGs. 25-26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Perazza to include categories of payees as taught by Simmons in order for the customer to view the amount paid in each category for use in budgeting and tax planning.

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Re claims 9 and 10: Perazza does not disclose:

wherein the customer payee information further comprises a payee type code. Simmons, however teaches identifying transaction by "3.Purpose" -see figs. 26 and 27.

wherein the customer payee information further comprises payee category information.-see Simmons (Tax category #3 Medical and Tax category #4 Entertainment) Fig. 25.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Perazza to include a payee information identifying which category and purpose assigned to a payee as taught by Simmons in order to facilitate bookkeeping for the customer.

Re claim 11: The Examiner is interpreting the following:

"the new form" to mean the statement provided to the customer by the financial institution which shows payments processed on behalf of the customer;

"the adding step" to mean designating the amount of the bill to be paid;

"the adding step is accomplished in part by being printed on the form by the financial institution " to mean that the financial institution prints out the payee information based on

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prior information provided by the customer and stored in the financial institution's computer database such as in the case of a recurring monthly bill that has a bill amount that is the same month to month;

"filled-in amounts" to mean the amounts to be paid to the appropriate payees;

"the correct funds transfer" to mean the amount to be paid to the appropriate payees is transferred by the bank;

"the new form" to mean the statement provided to the customer by the financial institution which shows payments processed on behalf of the customer.

Perazza discloses:

the customer determining payees to be included in the method ("Pre-Register means to provide a Payer's Bank with the following minimum information for a biller, as to a Bill Payer...")-see col. 2 lines 34-49, and col. 5 lines 56-63;

the financial institution providing to the customer a form with one listing per selected payee, including at least the payee name and a designated area to carry an amount to be paid to at least one such payee -("the bank produces a paper form, which is manually completed by the customer...The customer manually inserts the amount to be paid for each bill being

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processed by the system, opposite pre-printed indicia indicating the identity of the payee.")-see Abstract, and col. 6 lines 10-26,

adding into one or more of the areas the one or more amounts to be paid to the appropriate payees, wherein the adding step may be accomplished at least in part by the customer, and is accomplished at least in part by being printed on the form by the financial institution("The CPI provides space for the Bill Payer to designate manually...the amount of the Bill to be paid.")-see col. 5, lines 59-63 and ("Some Bills (mortgages, car loans, and the like) are fixed sums, payable each month, and each fixed amount can be Pre-Registered in the system of this invention, so that in these instances, at the option of the Payer's Bank, no information needs to be completed on the CPI, unless the Bill Payer wants to change the payment amount or the Designated Date.")-see col. 6 lines 21-27;

in response to the filled-in amounts, at the direction of the financial institution accomplishing the correct funds transfer to the appropriate payees ("the Payer's Bank has all information which it needs to be able to transfer funds to and credit the Biller's account and to provide Remittance Instructions to the Biller's Application, while debiting the account of the Bill Payer accordingly.")-see col. 6 lines 53-59;

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after accomplishing the funds transfer, the financial institution providing another form, and indicating on such form the most recent amount paid to each listed payee -see col. 15 line 63-col. 16 line 26.

Perazza does not disclose:

further comprising categorizing payees into budget categories, and indicating such on the form. Simmons, however teaches categorizing payees into tax categories such as Medical and Entertainment- see FIGs. 25-26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Perazza to include categories of payees as taught by Simmons in order for the customer to view the amount paid in each category for use in budgeting and tax planning;

wherein the new form also includes the amount paid to each listed payee year-to-date. Simmons however, teaches printing requested data for a payee and specified date ranges. -see Figs. 26 and 27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Perazza to include a financial institution providing a payment history to a customer for the desired date range, as was taught

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by Simmons in order to allow the customer to budget his/her finances.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,884,288 (Chang et al.)-cited for a method and system for electronic bill payment.

US Patent No. 6,289,322 (Kitchen et al.)-cited for electronic bill processing, bill summary, and categories of billers.

Shacklett, Mary. *Electronic Bill Presentment & Payment Is Around the Corner*. Credit Union Magazine. Mar 2000. pg. 12, 4 pgs.-cited for bill payment through credit unions and up to 24-month payment histories.

Esser, Julie. *Internet Banking Is a Virtual Necessity*. Credit Union Magazine. Madison: Oct. 1999. Vol. 65, Iss. 10; pg. 35, 2 pgs.-cited for Internet banking and bill payment, with 24 month payment history.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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